

Appn. Number 09/641,410 (Kiely)

GAU 1794

Response to Office Action

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Remarks General

Regarding Election/Restriction

Claims 403-416 are said to be rejected as being independent or distinct from the invention elected in response filed January 18, 2003.

The record shows that NO restriction of a product vs. method had been required in any Office Action for the above application. As far as Applicant is aware, choosing a species does not preclude one from including a method claim(s) if it is not independent or distinct from the elected species. See for example: 35 USC Section 101; 35 USC Section 112(6). As for the present instant rejection, Examiner has made no attempt to say how these claims are independent or distinct from Applicant's "examined" claims, as required, and therefore the rejection is improper for at least this reason.

Applicant cannot properly respond to this allegation. (MPEP ' 706.07(a)

Examiner's restriction is improper. MPEP 808.02. Applicant therefore respectfully requests withdrawal of the objection and reconsideration and allowance of the method claims.

Regarding Amendments to Specification:

The proposed amendments to the specification have been objected to under 35 USC 132(a) as said to introduce new matter into the disclosure. The added material which is said to not be supported by the original disclosure is as follows: the addition of "composite material" which is said to change the description from "a candy bar" to "a composite material candy bar" which is not the same as a generic term "candy bar" as originally described.

Applicant respectfully disagrees that the terminology "composite material" in the requested amendment is new matter. The term "composite material" is disclosed in original claims 6, 19-23,

and disclosed in drawings 27A-27E, 29-31 and 13A, and description of a composite support and "composite candy bar," which are all part of the original disclosure, *as originally filed*. As such, the specification may be amended to include the term "composite material." Please see: 2163.06 Relationship of Written Description Requirement to New Matter:

"...Stated another way, information contained in any one of the specification, *claims* or *drawings* of the application as filed *may be added to any other part of the application without introducing new matter.*"

Applicant's specification also teaches "composite candy bar," and copious examples of composite material candy bars including Milky Way, Snickers, Twix, Baby Ruth, Charleston Chew, Kit Kat, Butterfinger, and others. Applicant's "composite material" is fully enabled to one having ordinary skill in the art. As such, Applicant's requested amendment to the specification is proper.

Applicant therefore respectfully requests withdrawal of the objection and reconsideration and allowance of the amendments to the specification.

Applicant notes and appreciates the allowance to correct the typographical error regarding "caramel on top of the caramel" to "caramel on top of the cookie caramel."

**Applicant's Claims are Fully Enabled to One with Ordinary Skill
in the Art Regarding 35 USC Section 112 First Paragraph**

The claims are said to be rejected under 35 USC Section 112 first paragraph, for the introduction of new matter by recitation of the term "composite material" in the claims which is said to change the description of "a candy bar" to a "composite material candy bar, " which is not the same as a generic term "candy bar" as originally described.

As said many times previously, Applicant disagrees that the term, "composite material" in the claims constitutes new matter. The term "composite material" was fully disclosed as originally

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filed on August 18, 2000 in claims 6, and in claims 19-23, amply disclosed in the specification, and in the drawings, as above. "Composite candy bar with caramel, whipped chocolate nougat which is dipped in chocolate" in the specification clearly denotes a composite material, and "composite stick 62" with diagonally running ingredient materials within the composite stick clearly denotes a composite material, and numerous examples of composite material candy bars, such as Milky Way, Twix, and Kudos are used in the specification, as originally filed. Examiner's rejection is improper.

In view of this documented evidence, Applicant therefore respectfully requests withdrawal of the rejection and reconsideration and allowance of all the claims.

Furthermore,

5/2/2002 The Office Action required a restriction among:

- Species IVa, wherein the support is a candy bar
- Species IVb, wherein the support is a cookie bar
- Species IVc, wherein the support is a granola bar

The PTO had to have read and understood original claims 6, 19-23 in order to have made the restriction/election, directly above. Original claims 6, 19-23 August 18, 2000, recited:

6. The edible support of claim 1 wherein said support is a composite material, having a plurality of ingredients, said edible support being suited for a plurality of configurations and orientations, **wherein said support is a candy bar, wherein said support is a cookie bar, wherein said support is a granola bar.**

19. A supported comestible comprising:

- (A) a body of edible substance, and
- (B) an edible support suitable for supporting said body, wherein said support is a **composite material**, having a plurality of ingredients, said edible support having a....."

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21. The supported comestible of claim of 19 wherein said support is a candy bar.
22. The supported comestible of claim of 19 wherein said support is a cookie bar.
23. The supported comestible of claim 19, wherein said support is a granola bar.

12/19/2002 The Office Action required a restriction among:

Species I, wherein the comestible has a support as shown, e.g. in Fig. 1, or

Species II, wherein the comestible has a plurality of supports as shown e.g. in Fig. 35-39, and

Species III, wherein the support is a composite support as shown e.g. in Fig. 1, or

Species IV wherein the support is a homogenous support e.g. in Fig. 3

Since the wording of the restriction requirement was taken directly from original claims 6, 19-23, which recited "composite material," Examiner cannot maintain that the term "composite material" was not originally in the claims, is not enabled, or is new matter. Examiner cannot maintain the rejection as "new matter" when Examiner had already acted upon it in 2002.

Response to Note: It is of record that the term "composite material" is not new matter, is enabled, and has been acted upon to make a restriction by Examiner.

As above, the term "composite material" in the claims is proper, enabled, and does not introduce new matter. Applicant therefore respectfully requests withdrawal of the objection and reconsideration and allowance of the claims.

Claim Rejections 35 USC Section 112 Second Paragraph

Claims 383-402 are said to be rejected under 35 USC 112, second paragraph as being indefinite for the recitation of the terms "comprising a material comprising "two ingredient materials", "single component," "constituent ingredient materials."

The claims that included "ingredient material" have been clarified.

The term "bite size" is said to be indefinite in the claims and one of ordinary skill in the art is said to not be reasonably appraised of the scope of the invention.

In response, Applicant disagrees and respectfully submits that the term "bite size" is well known to one of ordinary skill in the art. In addition, issued patents including 5,800,855 to Elias for Method of preparing aerated gum confection (1985) mention "bite size" without dimensions either in the claims or elsewhere in the specification. Packages of cereal, such as generic brands, and name brands including "A&P" (tm) of granola, and cereal, and including Nabisco Shredded Wheat cereal, all recite "bite size." A myriad of snack and candy packages, including the bite size "Nestle Bites," (tm) whose exact image was repeatedly sent to Examiner, are all prevalent in the art and in today's society. The term "bite size" is clear under 35 USC section 112, second paragraph, and is well known to one having ordinary skill in the art of edible materials.

The term "mini" is said to be indefinite.

In response, the term, "mini" has been clarified.

The claims are said to be indefinite for the recitation of "composite material," under section 112, second paragraph.

In response, as above, Applicant respectfully disagrees. The term "composite material" is not indefinite. (See section 112, first paragraph, above) One skilled in the art of edible materials would not be confused by the term "composite material," as originally filed in the claims, and described in detail throughout the specification, illustrations, and corresponding explanations of the drawings. The term "composite material" is notoriously known throughout the world. (See patents issued by the PTO throughout the years that comprise the term "composite material.")

The Claims Recite Novel Structure and Distinguish Over Musher, Feybusch

N.B. Finality of the Next Action Is Precluded

Although the Summary of the past Office Actions indicates that claims 383 - 402 stand rejected, the Detailed Actions omit any explanation of how any cited art anticipates these claims. Applicant respectfully submits that this omission amounts to a failure to articulate a prima facie case of unpatentability and the burden to rebut this "rejection" has not yet shifted to the Applicant. Consequently, a next Office Action rejecting claims 383 - 402 cannot properly be made final since only then would the Applicant be obligated to rebut the rejection, presuming that such an Office action sets forth a prima facie case. (See MPEP ' 706.07(a)).

Specifically, in a previous Office Action, Applicant's claims 390, 394-402 "comprising a composite material" were said to be rejected by Examiner as being anticipated by Musher, without any evidence in support thereof.

In response, Applicant conveyed that the unit structure of Musher was comprised largely of voids to hold ice cream, and did not at least show a "solid material." (As per PTO's endorsed definition, below)

Examiner's "Ref. V 09/641,410," sent to Applicant, and endorsed by the PTO, from the Merriam-Webster's Collegiate Dictionary, Tenth Edition, page 236 defined: *Composite 4*: a solid material which is composed of two or more substances having different physical characteristics and in which each substance retains its identity while contributing desirable properties to the whole. [see attached]

Examiner had not addressed Applicant's response and omitted any explanation of how the cited reference to Musher anticipates Applicant's "composite material." This also amounts to a failure to articulate a prima facie case of unpatentability and the burden to rebut this "rejection" has not yet shifted to the Applicant.

Examiner again has rejected, but not specified, how the method claims are patently different than claims 383-402, as required, as above. This also amounts to a failure to articulate a prima facie case of unpatentability and the burden to rebut this "rejection" has not yet shifted to the Applicant.

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Additionally, the Examiner's citing of the new reference of Lane et al. (US 1690984) also precludes the next Office Action from being final.

Consequently, a next Office Action rejecting the claims cannot properly be made final since only then would the Applicant be obligated to rebut the rejection, *presuming that such an Office action sets forth a prima facie case*. (See MPEP ' 706.07(a)).

Musher States by His Own Hand That He Uses Separate Materials

2131 Anticipation - Application of 35 U.S.C. 102(a), (b), and (e) [R-1]

"A claim is anticipated only *if each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

On 07/09/09 pg.13(d), Examiner stated:

"Regarding the argument that Musher's support is not non-frozen" the applicant is reminded that the baked support and the flakes and nuts etc., as taught by Musher make the composite support structure, which comprises voids where the ice-cream mixture is poured and frozen. Applicant is further referred to page 4 of Musher, where Musher teaches molding of stick and other flake material into a support structure for the frozen confection and forming the structure and coating it. The formed and coated support structure of Musher is non-frozen prior to addition of liquid and freezing steps. Thus the composite support for a frozen confection as taught by Musher is not-frozen until the ice cream material is poured into the voids and the entire structure is frozen."

Applicant's Independent claim 383 first recites: "A support for a frozen comestible..."

This limitation clearly distinguishes over Musher who does not show a non-frozen support. *All of Musher's embodiments as made and completed* in the drawings, specification, and claims show a frozen support. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself..." MPEP 2113 Product-by-Process Claims. "...the end product, in both

the prior art and the allowed process...”

Patentability is based on the product itself. Therefore, Examiner’s rejection of Applicant’s claims based on Musher’s steps to make his unit structure is moot. Musher does NOT show a non-frozen support. Examiner has admitted to a plurality of materials that make Musher’s support. Examiner further has admitted and agrees that the support is fully frozen at the completion of Musher’s support: “...*Thus the composite support for a frozen confection as taught by Musher is not-frozen until the ice cream material is poured into the voids and the entire structure is frozen.*” (As above) Examiner has not established a prima facie case of anticipation. Therefore, for even this reason alone, Applicant’s non-frozen support legally passes the novelty requirement of section 102 over the reference to Musher.

This limitation further clearly distinguishes over as Musher’s invention requires a combination of a frozen support *and* a frozen comestible supported on the support. The fact that Musher’s invention is a *combined ice cream and support* in all embodiments and Applicant’s support does not require ice cream indicates that Applicant’s support is novel over that of Musher. For this additional reason, Applicant’s novel support further satisfies the novelty requirement of section 102 over Musher.

Claim 383 then recites: “... comprising an edible confectionary material, said edible confectionary material comprises two materials, wherein each of said two materials comprise one or a plurality of ingredients or substances, wherein each of said two materials pre-exist said edible confectionary material.”

This limitation further clearly distinguishes over Musher, as Musher does not show an edible confectionary material that comprises two materials.

As related many times, Musher *teaches* of the different materials of a coating, flakes, wheat flakes, shredded wheat, and bran flakes. None of Musher’s materials comprise two materials.

Musher by his own hand teaches:

“Also as a further embodiment, larger flakes, such as potato chips may be used, or dry melba toast *or other dry baked materials* may be used. Pg. 1, col. 2, lls. 15-20

“*With reference to the binding or coating materials of this invention...*” Pg. 2, col. 1, lls. 33-43

“The flakes *or similar materials* which form the unit structure, after they have been mixed or coated, or otherwise combined with the binder material...” (pg. 3, col. 1, lls. 71-74). (i.e different materials)

“... This *fat-milk mixture* is then sprayed, or coated, or otherwise applied to the flakes or structure pieces and is allowed to congeal thereon.” (Pg. 3, col 1, lls. 36-39)

Examiner states that claims 383 and 394 are rejected since:

“Musher teaches ice cream (frozen comestible) on an non-frozen edible support structure or a composite support which has at least two edible discernable (i.e. perceptible) edible confectionary materials or components that are combined together to make the support, i.e. two constituent ingredient materials....”

Examiner’s argument does not demonstrate that Musher has anticipated Applicant’s claims. Examiner does not negate Applicant’s edible confectionary material comprising two materials. Examiner agrees that Musher’s “at least two edible discernable (i.e. perceptible) edible confectionary materials or components are combined together to make the support,” and NOT combined together to make “a material.”

By statute, a U.S. patent is presumed to be valid. What a reference teaches is based on fact. Musher factually dictates, by his own hand, that his “unit structure” is made of many *different materials*. (see above) Examiner may not invalidate the existing facts of a

designer's invention, and maintain the rejection without any evidence. Giving a term the "broadest reasonable interpretation" does not entitle an examiner to ignore the facts given in a reference, or from responding to an Applicant's claim as written, i.e. unlawfully eliminating limitations/terms from Applicant's claims during examination to maintain rejections. Applicant's claims are clearly not anticipated. Musher does not show two materials in any of his materials.

Musher did not envision using A material comprising two materials in 1939. Applicant's material shows an overwhelming and markedly different material than that of any of the materials of Musher and the cited art. For this additional reason, Applicant's novel support, having physically different structure, legally satisfies the novelty requirement of section 102 over Musher. Examiner has not established a prima facie case of anticipation.

Feybusch Did Not Envision A Composite Material

In 1926

Claims 383-390, 392-402 are said to be rejected as being anticipated by Feybusch (US 1638480), as the support or cone taught by Feybusch comprises of two ingredient materials, i.e. cone making pastry material (such as sugar, flour etc) and edible adhesive material, such as, molasses, and popcorn or nuts or brittle or puffed rice. The ingredients sugar, water and flour etc., that are typical ingredient of the pastry cone as taught by Feybusch comprise an ingredient in the support as recited in claims 383-385 and 394-396.

Examiner's argument does not demonstrate that Feybusch has anticipated Applicant's claims. Examiner agrees that different materials each of 1) cone, 2) adhesive, 3) popcorn, 4) nut, 5) brittle, 6) puffed rice, are used.

Applicant's Independent claim 383 recites: "A support for a frozen comestible comprising an edible confectionary material, said edible confectionary material comprises two materials..."

This limitation clearly distinguishes over Feybusch who does not show an edible confectionary material that comprises two edible materials. Baked cone does not show two materials, since it shows only one material. Peanut brittle is a hard-crack boiled candy, which as cooled and completed, also does not show two materials, but one. Molasses does not show two materials. Corn does not show two materials. The sugar, water and flour of Feybusch's cone do not show a bite size confectionary material comprising two. Therefore, Applicant's novel edible confectionary material comprising two materials passes the novelty requirement of section 102 over Feybusch.

Independent claim 394 recites: "A support for a frozen comestible comprising an edible composite material."

This limitation clearly distinguishes over Musher, as Musher does not show a non frozen support. Musher's support is frozen in all embodiments. Applicant's non-frozen support is novel over the frozen support of Musher and therefore legally passes the novelty requirement of 35 U.S.C. section 102.

This limitation also clearly distinguishes over Musher, as Musher does not show a non-frozen edible composite material as all of his materials are frozen, which additionally satisfies the novelty requirement of section 102.

This limitation further clearly distinguishes over Musher, since Musher's invention requires a frozen support *and* a frozen comestible supported on the support in each and every embodiment of his invention. Applicant's support is novel over the combined support and ice cream of Musher's supported "Frozen Confection." Therefore, Applicant's support for a frozen comestible is physical hardware that is novel over that of Musher, as above. Therefore, Musher has not anticipated Applicant's support, which is novel, and additionally satisfies the novelty requirement of section 102.

This limitation further clearly distinguishes over Musher, as Musher's does not show an

edible composite material. Musher does not at least show a material that comprises two materials, as needed for a composite material, and therefore does not show a composite material. Applicant's support therefore has novel physical structure over Musher and legally satisfies the novelty requirement of section 102.

707.07(g) Piecemeal Examination

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, how-ever, undue multiplication of references. (See MPEP § 904.03.)

Examiner has cited references to Feybusch (US 1638480) eight years after filing on 4/30/08 and Lane et al. (1690984) nine years after filing on 7/9/09. Lane has been brought up for the first time during the time of a Final Office Action. Examiner is partaking in improper piecemeal examination for nine years contrary to MPEP 707.07(g).

This limitation also clearly distinguishes over Feybusch, as none of his materials of usual pastry cone, molasses, hard crack peanut brittle, corn, or nut show two materials, but only one, as above, and therefore does not show a composite material. Feybusch uses three or more different materials, not a single material comprising two materials. Cone, item 10, molasses, item 11, and particulate, item 12. "...to provide the pastry of the cone with an outer layer of edible material....provide the same with a coating 11 of an edible adhesive material...then rolled in popcorn... form an outer layer 12 on the exterior of the cone" (Pg 1 of text, col. 1, lls. 56- col. 2, lls. -68). All prove *different* materials are used.

Independent claim 403 is a means claim.

Independent 405 recites: "A method of making a support for a frozen comestible comprising comprising an edible confectionary material comprising two materials..."

This limitation clearly distinguishes over Musher who does not show a material that comprises two materials, a non-frozen support, or a "support only," as above.

This limitation also clearly distinguishes over Feybusch, since Feybusch does not at least show an edible material that comprises two edible materials.

Independent claim 412 recites: A method of making a support for a frozen comestible comprising comprising an edible confectionary material comprising two materials to make a support for a frozen comestible...

This limitation also clearly distinguishes over Musher and Feybusch, as neither at least show an edible confectionary material that comprises two materials.

Therefore, Applicant's support is novel over both the cited references of Musher and Feybusch under 35 USC section 102.

Applicant respectfully requests reconsideration of the claims and withdrawal of the rejections with regard to section 102.

Applicant's Edible Support is Not Obvious Regarding Feybusch

In View of Lane Under Section 103

Claim 391 is said to be rejected under 35 USC 103(a) as being unpatentable over Feybusch in view of Lane et al. (US1690984). Examiner states: It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Feybusch based on the teachings from Lane and make the edible support comprising one material that has hollow confection length and another component that comprise a filling placed in said hollow length.

The relied upon references:

Feybusch teaches of a usual cone, item 10, a coating on the outside of a usual cone, item 11, which is then rolled in popcorn, or the like, item 12, as above.

Lane teaches of an inner cone, item 11, and an outer cone, item 12, and a filling, item 13, placed in between the two different cones.

Applicant's dependant claim **391** recites: The support for a frozen comestible of claim **383** wherein one of said two materials comprises an edible hollow confection length, wherein the other of said two materials comprises an edible filling placed in said hollow length, wherein said filling comprises a plurality of candy beads, colored sugar, flavored sugar, an edible confection rope, or a fluid ingredient, wherein said two materials comprise two materials placed concentrically.

This limitation clearly distinguishes over Feybusch as at least none of Feybusch's materials comprise two materials, since claim 391 comprises the limitations of claim 383, as above.

This limitation clearly distinguishes over Lane, who's cone, whether it be the inner cone or the outer cone, does not show two materials. Lane's filling also does not show two materials.

Accordingly, as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the modification of Feybusch in view of Lane does not render Applicant's claim 391 obvious since at least the combined teachings cannot produce a material comprising two materials, as all of their materials each show only one material. Therefore, Applicant's claim 391 is not obvious with regard to a modification of Feybusch in view of Lane.

Applicant respectfully submits that the independent claims are all novel and unobvious, and that the claims be reconsidered and the rejections withdrawn with regard to section 103.

Applicant's Novel Support Shows Unexpected Results

Applicant's edible material provides unique and unexpected results. No prior art known to Applicant has made a support that comprises an edible material comprising two materials. No prior art known to Applicant has made a support that comprises a composite material. Among other things, Applicant's support comprises synergism. Applicant's support can be made with caramel, which has "give" to it and which can hold a fractured cookie together and still be used dependably to support a frozen confection. An example is a support comprising the ingredients of a Twix (tm) candy/cookie bar. The caramel layer of a Twix Bar can hold the cookie portion together if the cookie is broken during transit to still dependably support ice cream. Applicant's support can be made faster than that of the cited art, is less expensive to make with regard to material, use of machinery and man hours. Applicant's edible materials can be layered, mixed, swirled, twisted, placed concentrically, or in any direction, or any combination of directions needed to make a very strong support. The cited art cannot do this.

Applicant's material can be made in any thickness and in any shape, with or without voids, is limitless in its configurations, variety of designs, flavors, and textures, and is not relegated to a preconceived structure, as is the prior art.

Applicant's material can also be a handle to hold, and a unique bite-size ingredient inside or outside the support. Applicant includes a composite material for making either part of a support or the support itself. The prior art has never considered or included, or used a composite material in a support for a frozen comestible, as far as Applicant is aware. The support may even assist to keep a supported frozen comestible colder while it is being eaten from the inside out. This is truly novel. The incorporation of synergism to resist stress against breakage into a support for a comestible is also truly unique, unanticipated, and novel, with unexpected and advantageous results.

Response to Examiner's Arguments:

Applicant does not agree with Examiner's Arguments or with comments on pages 11-14 of the Office Action.

Examiner has continued to eliminate a limitation(s) from Applicant's claims during examination to maintain rejection, without any evidence. Examiner is also non responsive to Applicant's pertinent arguments. Therefore all of Examiner arguments are moot and improper, i.e. unresponsive.

Conclusion

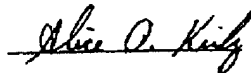
For all of the above reasons, Applicant submits that the claims define novel structure under §102, which novel structure is unobvious and thus patentable under §103. The dependent claims recite additional features and therefore Applicant respectfully submits that they are all a fortiori allowable. Accordingly, Applicant respectfully submits that allowance of claims 383-418 is proper and Applicant respectfully requests allowance of the claims.

Conditional Request For Constructive Assistance

Applicant submits that she has a novel and unobvious invention. She has made a diligent effort to amend the claims of this application so that they recite novel features of her invention, which she submits are unobvious. If, for any reason, the Examiner believes that the claims of this application are not yet in full condition for allowance, Applicant respectfully requests the Examiner's constructive assistance and suggestions pursuant to the spirit of MPEP §706.03(d) and §707.07(j). This will enable the undersigned to place this application in fully allowable condition as soon as possible and without the need for further proceedings.

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Very Respectfully,



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Attached:

Merriam-Webster Collegiate Dictionary, tenth addition, copy of Examiner's definition of "composite material" sent to Applicant. 3 pages.

Certificate of Facsimile: I certify that on the date below, this document and referenced attachments, if any, will be faxed to the central fax number of 571-273-8300 to the United States Patent and Trademark Office "Commissioner for Patents" Arlington, Virginia 22313.

2009 October 9,



Alice O. Kiely

Ref V. 09/64/4/6



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